

09/826,680
Art Unit 3622
Docket 8717

REMARKS

This Amendment is submitted in response to the Office Action mailed on December 23, 2005. Claims 16 - 32 are pending, and all stand rejected at present.

SUMMARY OF ARGUMENT

Drummond Reference

The Drummond reference is not available. Applicant's filing date precedes the effective date of the Drummond reference itself. Parent applications of the Drummond reference may have better dates, but Drummond is a CIP, and the parent applications found do not contain the subject matter needed to reject the claims.

Claims 27 and 29: Claimed Parties not Found in Reference

Claim 29 recites

- 1) providing a database of advertisements
(Recitation 1) and
- 2) allowing a "third party" access to the database, to supply advertisements (Recitation 2).

In Drummond, an ATM visits web sites, and downloads web pages containing advertising. The PTO treats that as Recitation 1, namely, the claimed providing a database of advertisements.

However, in Drummond, it is clear that the **owner of the web**

09/826,680
Art Unit 3622
Docket 8717

site supplies the advertising to the web site. Thus, that owner does Recitation 2.

So, in Drummond, **the SAME PARTY** performs both Recitation 1 and 2.

Therefore, in Drummond, there is no "third party" present. In the claim, the "third party" (which does Recitation 2) is **different from** the party which provides the database of advertisements (Recitation 1). Drummond does not show that different (third) party.

Consequently, even if Drummond is available as a reference, the two different parties recited are not found.

This applies to claim 27.

Claim 18

Point 1

This claim states that the ATM contains a browser which is made usable to a customer at predetermined "allocation times."

The Office Action cites paragraph 114 of Drummond as showing this. The only discussion of timing in that paragraph is a statement that certain material displayed may be selected based on "other factors such as the day of the week and time of day."

That does not show the claim recitation of making a browser available at "allocation times."

09/826,680
Art Unit 3622
Docket 8717

Point 2

The item which Drummond makes available to a customer in paragraph 114 is a display which contains "personalized content" for a customer.

That is not a web browser.

Claim 21

The claim recites recording ("logging") the number of times an advertisement database was accessed, and generating a bill accordingly.

Drummond's paragraph 116 is cited to show the claimed billing. However, that paragraph contains only two references to payment, and they both, in essence, state that advertisers pay for promotion of the advertising.

That does not show the specific claimed approach to billing for advertising.

Claims 25, 27, and 29

Claim 25 recites "screening" of submitted advertising (for example to assure that it is not offensive). Drummond shows that nowhere.

This applies to claims 27 and 29. In addition, claims 27 and 29 state that the advertising is rejected if the screening shows that the advertisement fails to meet a criterion. Drummond does

09/826,680
Art Unit 3622
Docket 8717

not show that.

END SUMMARY

Response to Anticipation Rejections

All claims were rejected on grounds of anticipation, based on Drummond, a published U.S. Application, US 2005/0216888, which will be called "Drummond '888" in this section.

Drummond '888 not Available as Reference

Applicant's filing date of April 5, 2001, precedes the publication date of Drummond, which is September 29, 2005. Therefore, Drummond cannot be used as a printed publication.

Further, Applicant's U.S. filing date of April 5, 2001, precedes Drummond's U.S. filing date of January 31, 2005. Therefore, Drummond cannot be used as an application having a filing date prior to Applicant's date of invention.

It is possible that Drummond can rely on an effective date of one of his parent applications. However, Applicant's foreign priority date precedes the filing date (Aug 14, 2000) of Drummond's application 09/638,848. Therefore, that particular parent cannot be used as a reference.

Drummond's published application WO 98/24041, which was published on June 4, 1998, may have a publication date prior to Applicant's foreign priority date. However, that published

09/826,680
Art Unit 3622
Docket 8717

application does not show Applicant's claims. Therefore, it is clear that the subject matter in Drummond '888 which is used to reject Applicant's claims was added after the filing date of this WO application. A copy of this published WO application is herewith enclosed, in PDF format, on a compact disc.

Applicant's assignee attempted to obtain a copy of Drummond's application 09/193,787. However, it appears that this application has been revived, and is presently not available to the public.

In view of the foregoing, Applicant requests that, if the PTO wishes to rely on Drummond '888, that the PTO present a document which

- (1) provides Drummond '888 an effective date prior to Applicant's foreign priority date and
- (2) shows the claimed subject matter.

Applicant submits that a document must be presented which

- 1) has an effective date which precedes Applicant's filing date and
- 2) shows the subject matter of the paragraphs of Drummond '888 which are relied upon to reject the claims.

Until such a document is presented, Applicant submits that the rejections should be withdrawn.

09/826,680
Art Unit 3622
Docket 8717

Response to Rejection of Claims 16 and 19

Drummond '888 will now be called "Drummond."

Claim 16 recites:

16. An automated teller machine (ATM)
. . . comprising:

. . .
means for accessing an advertisement database to retrieve an authorized advertisement associated with the ATM; and

means for incorporating the retrieved advertisement in a screen for displaying on the ATM display to allow the ATM customer to view the screen while the ATM customer is conducting the cash dispense transaction at the ATM.

Applicant points out that the claimed retrieval of an advertisement, and display of it, is not found in Drummond's published application WO 98/24041. Further, as explained above, Drummond '888 is not itself usable as prior art, nor is Drummond's application 09/638,848.

Therefore, these claim elements have not been shown in the prior art. MPEP § 2131 states:

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

The preceding applies to claim 19.

09/826,680
Art Unit 3622
Docket 8717

Claim 17

The discussion of claim 16 applies to dependent claim 17.

Claim 18

This claim states, speaking generally, that the ATM contains a browser which is made usable to a customer at predetermined "allocation times."

The Office Action cites paragraph 114 of Drummond as showing this. However, that paragraph discusses creation of a display which is personalized, or otherwise contains content which is specific to the customer. The only discussion of timing in that paragraph is a statement that the personalized content may be selected based on "other factors such as the day of the week and time of day."

While exactly how the "other factors" can be used is not clear, perhaps Drummond intends to refer to something like the following. During business hours, the personalized content may offer the customer an application for a credit card. However, on Friday and Saturday evenings, perhaps no offer of a credit card is made.

In any case, Drummond's proposal of altering the personalized content based on day-and-time does not show the claimed restriction of making a web browser available at "allocation times."

09/826,680
Art Unit 3622
Docket 8717

-- Drummond does not show a "browser" in the cited passage;

-- He does not show a "browser" made available at "allocation times."

Claim 20

Claim 20 recites:

20. A method of supplying an advertisement for displaying on a display of an automated teller machine (ATM) which can dispense cash in the form of paper money to an ATM customer conducting a cash dispense transaction at the ATM, the method comprising the steps of:

accepting via a network an identification signal from an ATM located on the network;

accessing an advertisement database to retrieve an authorized advertisement associated with that ATM; and

transmitting the retrieved advertisement to the ATM for displaying on the display at that ATM to allow the ATM customer to view the displayed advertisement while the ATM customer is conducting the cash dispense transaction at the ATM.

Applicant points out that none of the claim recitations are found in Drummond's published application WO 98/24041. Further, no Drummond application having an effective date prior to Applicant's date, and showing the claim recitations, has been set forth.

Claim 21

The claim recites recording ("logging") the number of times an advertisement database was accessed, and generating a bill accordingly.

As explained above, no advertising database has been shown in a usable reference. Thus, this claim element has not been shown in the prior art.

Also, Drummond's paragraph 116 is cited to show the claimed billing. However, that paragraph contains only two references to payment.

-- One is a statement that the owner of a machine may "sell paid advertising."

-- The second is this:

The operator of the machine . . .
may require payment from advertisers
for presenting the advertising
materials.

Neither reference shows the claim recitation. The claim states that a billing is generated, based on the number of accesses to a database. Even if the Drummond reference is available, the cited passage in it only refers to payment for advertising. That does not show, or imply, the specific billing method recited in the claim.

09/826,680
Art Unit 3622
Docket 8717

For example, in Drummond, an advertiser may pay \$ 1000 for the option to place 10 advertisements at **any times he wants**, or pay a lesser sum if the ads are placed at inconvenient times. That does not show the claimed invention.

Claim 23

Claim 23 is considered patentable, based on its parent.

Claim 24

The Office Action cites Drummond's paragraph 121 to show this claim. However, the claim recites the entering of "descriptive fields" by a user. The undersigned attorney cannot locate that specific term in paragraph 121, nor anything synonymous. Therefore, it is requested that the "descriptive fields" be precisely identified in paragraph 121.

Claim 25

This claim states that "screening" is done to determine whether the advertisements meet certain criteria. Plainly, in "screening," some examination is done as to the effects, or results, of the advertising.

The Office Action cites Drummond's paragraphs 103, 121, and 122 to show the "screening." But no examination as to effects, or results, of the advertising is found in those paragraphs. Thus,

09/826,680
Art Unit 3622
Docket 8717

it is requested that the precise location of the "screening" be identified.

Further, the claim states that the advertisement is rejected if it does not meet the criterion. That is not seen in Drummond.

Claim 27

This claim is fundamentally different from Drummond, even if Drummond is available as a reference.

The passages cited in Drummond to show the claim (paragraphs 103, 116, 121, and 122) essentially state that an ATM can access web sites, and display web pages to customers.

However, claim 27 states that an **ATM customer** can transmit an advertisement to a database for storage. That means that the advertisement is transmitted from the ATM to the database. An amendment to the claim makes that clear.

That is not shown in Drummond.

Further, the claim states that the advertisement is stored in a database entry "associated with the ATM." That is not seen in Drummond. Applicant points out that, in the claim, three particular steps are not found in Drummond.

One, the "authorized ATM customer" transmits the advertisement to the database.

Two, the "screening" is done.

Three, after "screening," the advertisement is

09/826,680
Art Unit 3622
Docket 8717

stored in "a database entry associated with
the ATM."

That combination of three steps has not been found in
Drummond.

Claim 29

POINT 1

An amendment is added stating that the steps of the claim are undertaken by a single entity and its agents. This amendment is seen as unnecessary, since a "method" is recited. In a method claim, the steps must be performed by one, or more, parties acting in concert.

That is, if persons perform the steps of a method claim, but the persons are unaware of each other, or do not act in concert, then the method claim is not found. From another point of view, if all the steps of a method claim are found at various locations throughout the world, but being performed by independent parties, the method claim is not found.

Applicant submits that the PTO is reading claim 29 in this manner. That is, the PTO is asserting that numerous, independent web sites, which may provide advertising, show the "providing a database . . ." step of claim 29. However, that cannot be so. The parties providing the advertising in Drummond do not perform the other steps of the claim, and are independent of the parties who

09/826,680
Art Unit 3622
Docket 8717

do perform those other steps.

Thus, the parties who perform all steps are not acting together.

POINT 2

The claim states that, during screening, if the advertisement meets a criterion, then it is stored. Plainly that implies that some advertisements will be rejected. An amendment emphasizes this.

No advertisements in Drummond are rejected. Therefore, the claim recitation is not found.

POINT 3

The claim recites "providing a database for storing . . . advertisements." Call this Recitation 1.

The claim also recites "allowing a **third party** to access the database and to transmit advertisements thereto." Call this Recitation 2.

Thus, **two different parties** are recited in the claim:

- 1) the one performing the "providing" of Recitation 1, and
- 2) the "third party" of Recitation 2.

According to the PTO, web sites in Drummond store the claimed advertisements. Thus, the owner of the web site performs the

09/826,680
Art Unit 3622
Docket 8717

"providing" of Recitation 1.

Consequently, the owners of the web sites also "transmit advertisements" to the database, as in Recitation 2.

Therefore, the **two different parties** of the claim are not found in Drummond. In Drummond, **the same party** (1) performs the "providing" of Recitation 1 and (2) performs the transmitting of Recitation 2.

Claims 31 and 32

Claims 31 and 32 are considered patentable, based on their parents.

09/826,680
Art Unit 3622
Docket 8717

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 4
Dayton, OH 45479
March 23, 2006

(937) 445 - 4956